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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/526,364	09/06/2005	Dietmar Pennig	7202-78	3372

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AKERMAN SENTERFITT  
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EXAMINER
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WOODALL, NICHOLAS W

ART UNIT	PAPER NUMBER
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3733

MAIL DATE	DELIVERY MODE
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05/01/2007

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

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## Office Action Summary

Application No.

10/526,364

Applicant(s)

PENNIG, DIETMAR

Examiner

Nicholas Woodall

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3733

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 09 February 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-7, 9-21 and 23 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 23 is/are allowed.
- 6) ☒ Claim(s) 1-7, 9-12, and 15-21 is/are rejected.
- 7) ☒ Claim(s) 13 and 14 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 09 February 2007 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☒ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)          | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

### **DETAILED ACTION**

1. This action is in response to applicant's amendment received on 02/09/2007.

#### ***Drawings***

2. The drawings were received on 02/09/2007. These drawings are acceptable.

#### ***Priority***

3. Acknowledgment is made of applicant's claim for foreign priority based on an application filed in the European Patent Office on 09/03/2002. It is noted, however, that applicant has not filed a certified copy of the European application number EP20020019637 as required by 35 U.S.C. 119(b). The examiner notes that the applicant is in the process of retrieving and filing this document.

#### ***Double Patenting***

4. The examiner would like to note that the applicant has filed a terminal disclaimer to overcome the double patenting rejection set forth in the previous office action.

#### ***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 1-7, 13, and 15-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Baumann (U.S. Patent 4,101,985) in view of Niiranen (U.S. Patent 6,692,498).

Regarding claims 1 and 15, Baumann discloses a device comprising a humeral nail capable of being placed in a humeral shaft and an intermediate plate element. The humeral nail includes at least one proximal transverse hole and a screw including a screw head and a screw body. The intermediate plate element is in the form of a plate washer located between the screw head and the bone surface. The intermediate plate element is slightly bent. Regarding claims 2 and 16, Baumann discloses a device wherein the intermediate plate element is slightly curved. Regarding claims 7 and 21, Baumann discloses a device wherein the intermediate plate has a substantially rounded profile. Baumann discloses the claimed invention except for the intermediate plate element comprises a couple of elongated arm portions that are in a position astride of a set screw (claim 1), that the elongated arm portions are rounded on the ends (claims 3 and 17), the intermediate plate element comprises an enlarged portion having at least a seat for embracing a fixation element (claims 4 and 18), the seat is at least a hole formed in the elongated portion of the intermediate plate element (claims 5 and 19), the seat is at least a hole in one of the elongated arm portions of the intermediate plate element (claims 6 and 20). Niiranen teaches an intermediate plate element that can be manufactured to any number of forms and sizes desired in order to best utilize the plate for the desired use of the plate (column 9 lines 23-50; claims 1, 3, 4, 7, 8, 11, 17, 18, 19, 21, and 22). Niiranen shows a plate element, such as a Y-shaped plate, that has elongated arms that are inherently capable of being placed astride of a screw and an elongated portion. The arms of the plate are shown to be substantially rounded. Niiranen teaches that the intermediate plate element may contain a plurality of holes in

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order to pass fasteners through the plate (column 9 lines 37-39; claims 4, 5, 6, 18, 19, and 20). Niiranen shows the holes passing through different areas of the plates including what would be the arms and enlarged portions of the Y-shaped plate. The Y-shaped plate is only an example of the shapes of plates Niiranen teaches. The examiner interprets Niiranen to include any number of plate shapes including C-shaped or U-shaped plates, which would also read upon the claim limitations for an open washer in the current application. It would have been obvious to one having ordinary skill in the art at the time of the invention to manufacture the system of Baumann with the shapes and plurality of holes of the plates of Niiranen in order to best utilize the plate for the desired use and to allow the passage of fasteners through the plate.

Regarding claims 9 and 11, it would have been obvious to one having ordinary skill in the art at the time the invention was made to construct the device of Baumann modified by Niiranen to include a plurality of intermediate plate elements, since it has been held that mere duplication of the essential working parts of a device involves only routine skill in the art. *St. Regis Paper Co. v. Bemis Co.*, 193 USPQ 8.

Regarding claims 10 and 12, Baumann in combination with Niiranen disclose the claimed invention except for the second intermediate plate element being larger than the first intermediate plate element and that the arms of the second intermediate plate element are larger than the arms of the first intermediate plate element. It would have been an obvious matter of design choice to make the second intermediate plate element and the arms of the plate larger in size than the first intermediate plate element and the arms of the plate, since such a modification would have involved a mere

change in the size of a component. A change in size is generally recognized as being within the level of ordinary skill in the art. In re Rose, 105 USPQ 237 (CCPA 1955).

***Allowable Subject Matter***

8. Claim 23 is allowed.

9. Claims 13 and 14 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

***Response to Arguments***

10. Applicant's arguments with respect to claims 1-7, 9-21, and 23 have been considered but are moot in view of the new ground(s) of rejection. The examiner has provided a new ground of rejection as discussed above. Because the examiner failed to mention claims 8 and 22 in the 103 rejection from the previous office action, this office action is non-final. The examiner never stated the claims were allowable. The examiner felt the previous 103 rejection read upon claims 8 and 22, but did not state so in the rejection. Regarding applicant's argument that Niiranen has little in common with the claimed invention is not persuasive. Niiranen shows a plate element that is capable of being manufactured in numerous shapes and configurations, which is the idea the examiner is teaching from the reference. Therefore, the teaching of Niiranen to manufacture a plate in numerous shapes and configurations is relevant to the claimed invention. Regarding applicant's argument that Niiranen teaches a Y-shaped plate element with a V-shaped seat teaches away from sliding a plate under the already inserted screw is not persuasive, since the limitations the applicant relies on, i.e. the

plate sliding under the inserted screw, are not presented in the claims. Therefore, it is irrelevant if the reference contains them or not. Regarding the applicant's argument that the Y-shaped plate of Niiranen cannot permit the stable insertion of a screw in multiple directions is not persuasive. First, the Y-shaped configuration taught by Niiranen is only one possible configuration that is taught that reads upon the claim limitations of the current application. The examiner believes the reference teaches further configurations, such as a C-shaped plate or a U-shaped plate, which would also read upon the claim limitations of the current application. Furthermore the functional limitation of permitting the stable insertion of a screw in multiple directions is not presented in the claims. Therefore, it is irrelevant if the reference contains them or not. Also, a C-shape plate or a U-shape plate, which the examiner believes is taught by the reference, would read upon the functional limitation of being capable of the stable insertion of a screw in multiple directions if the language were added to the claims.

### ***Conclusion***

11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. See PTO-892 for cited references the examiner felt were relevant to the application.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nicholas Woodall whose telephone number is 571-272-5204. The examiner can normally be reached on Monday to Friday 8:00 to 5:30 EST..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eduardo Robert can be reached on 571-272-4719. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

NWW



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SUPERVISORY PATENT EXAMINER